DISCUSSION OF THE AMENDMENT

Due to the length of the specification herein, Applicants will cite to the paragraph number of the published patent application (PG Pub) of the present application, i.e., US 2006/0205709, when discussing the application description, rather than to page and line of the specification as filed.

The claims have been amended to recite a method for treating a retinal nerve disease comprising administering to a subject in need thereof the recited alkyl ether derivative, and by inserting a Markush group for retinal nerve diseases, as supported in the specification at, for example, paragraph [0513].

Claim 2 has been amended by deleting superfluous language.

New Claims 8-16 have been added. Claim 8 is supported by Claim 2. Claim 9 is drawn to the elected species. Claim 10 is supported in the specification at paragraph [0505]. Claims 11-16 are drawn to the specific retinal nerve diseases inserted into above-discussed Claim 1, respectively.

No new matter is believed to have been added by the above amendment. Claims 1-16 are now pending in the application.

REMARKS

The rejection of Claims 1-7 under 35 U.S.C. § 102(a) as anticipated by WO/03/035641 [sic, WO03/035647] (WO Saitoh et al), is respectfully traversed. WO Saitoh et al has a publication date of May 1, 2003. The present application, on the other hand, has an international filing date of April 15, 2004, claiming foreign priority of JP 2003/112539, filed April 17, 2003 (priority application). **Submitted herewith** is a certified English translation of the priority application. The Examiner is respectfully requested to find that Applicants are entitled to their foreign priority date. Accordingly, WO Saitoh et al is removed as prior art, and the Examiner is respectfully requested to withdraw this rejection.

The rejection of Claims 1-7 under 35 U.S.C. § 102(e) as anticipated by US 7,087,594 (US Saitoh et al) in view of Moalem et al, The FASEB Journal, Vol. 13, July 1999 1207-1217 (Moalem et al), is respectfully traversed.[1] US Saitoh et al discloses the compounds described therein as, *inter alia*, useful as a therapeutic agent for diseases in central and peripheral nerves (column 107, lines 34-39). The Examiner relies on Moalem et al as disclosing that the optic nerve represents the central nervous system (CNS). Particularly, Moalem et al discloses "[i]mmunocytochemistry revealed a significantly greater accumulation of endogenous T cells in the injured rat sciatic nerve than in the injured rat optic nerve (representing PNS and CNS white matter trauma, respectively.)"

The above-amended claims are drawn to a method for treating a retinal nerve disease selected from a particular Markush group of such diseases. In order for US Saitoh et al to

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[1] That the new prior art, i.e., Moalem et al, is not listed in the statement of the rejection is irrelevant; reliance thereon is all that is necessary. "Where a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of rejection." *In re Hoch*, 428 F.2d 1341, 166 USPQ 406, 407 n.3 (CCPA 1970). See also MPEP 706.02(j).

anticipate the presently-claimed invention, it must contain every limitation of the rejected claims. US Saitoh et al does not disclose any of the retinal nerve diseases within the terms of the present claims. Thus, at best, US Saitoh et al is available under 35 U.S.C. § 103(a) only. However, Applicants' assignee represents that at the time the present invention was made, it and the subject matter of US Saitoh et al were commonly owned. Thus, under 35 U.S.C. § 103(c), US Saitoh et al is removed as prior art.

For all of the above reasons, it is respectfully requested that this rejection be withdrawn.

The rejection of Claims 1-7 under 35 U.S.C. § 112, second paragraph, as indefinite, is respectfully traversed. Indeed, the rejection would now appear to be moot in view of the above-discussed amendment. Accordingly, it is respectfully requested that the rejection be withdrawn.

The rejection of Claims 1-7 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement, is respectfully traversed. Indeed, the rejection would now appear to be moot, since the above-amended claims are drawn to a method for treating. The Examiner finds, however, that Applicants have not enabled treatment of macular degeneration, finding that its etiology is unknown and thereby not directed to retinal ischemia.

In reply, **submitted herewith** is a copy of Xuan et al (J. Ocul. Pharmacol. Ther., 1999 Apr., 15(2), page 135-42 and page 143-52). Xuan et al discloses, in the last sentence of the ABSTRACT (page 135) and the second sentence of the ABSTRACT (page 143), that age-related macular degeneration is caused by the choroidal vascular abnormality and/or insufficiency. Thus, in an assay system disclosed in the present specification, it has been fully demonstrated that the claimed compound can be used for the treatment of macular degeneration. Accordingly, it is respectfully requested that the rejection be withdrawn.

The rejection of Claims 1-7 under 35 U.S.C. § 112, first paragraph, as failing to comply with a written description requirement, is respectfully traversed. The Examiner finds that the specification inadequately describes what conditions were in possession of Applicants (other than glaucoma, diabetic retinopathy, retinal artery obstruction, retinal venous obstruction, macular degeneration and retinopathy of prematurity). Thus, the rejection would now appear to be moot in view of the above-discussed amendment. Accordingly, it is respectfully requested that the rejection be withdrawn.

Applicants respectfully traverse the Examiner's failure to consider the reference AW, listed on the Form PTO-1449 for the Information Disclosure Statement (IDS) filed October 14, 2005, i.e., Hyojun Ganka Gaku (Gaku). Gaku is described in the specification at paragraph [0002]. According to MPEP § 609.04(a)III., the above-cited disclosure qualifies as a concise explanation of relevance. Accordingly, **submitted herewith** is another copy of said Form PTO-1449. The Examiner is respectfully requested to initial said form next to reference AW, and include a copy thereof with the next Office communication.

Applicants respectfully submit that the elected species is now allowable. The Examiner is respectfully requested to extend her search and examination to non-elected species and in the absence of further grounds of rejection, pass this application to issue with all pending claims.

Respectfully submitted,

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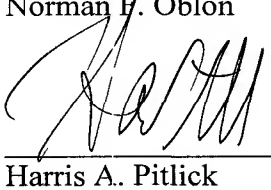
Norman F. Oblon



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